

REMARKS

The Office Action mailed May 24, 2005, maintains the rejection of Claims 1–7, 9, 14–23 and 25 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,609,113 (“O’Leary”); and of Claims 8, 10–13 and 24 under 35 U.S.C. § 103(a) as unpatentable over O’Leary in view of U.S. Publication No. 2002/005400 (“Chien”). The rejections are again respectfully traversed and the following remarks are intended to present the application in better form for consideration on appeal.

1. Independent Claims 1 and 14

In the section captioned “Response to Arguments,” the Office Action clarifies that a correspondence is being drawn between O’Leary’s description of a “transaction ID” with the “credential” recited in the claim:

In particular O’Leary et al. teaches that the merchant assigns the buyer a unique transaction ID (credential), which has to be reconciled/validated during an Electronic Fund Transfer (EFT) (column 14, lines 58-63). The merchant transmits to the system the transaction ID/credential, along with the dollar amount of the transaction (cost of transaction) (column 16, lines 1-5).

(Office Action, page 2, lines 10–14).

While Applicants agree with this portion of the Office Action’s characterization of O’Leary, they continue to disagree that what O’Leary discloses is the same as what is claimed. In particular, in addition to requiring receipt of a first information packet comprising the credential from the Internet merchant, independent Claim 1 requires “determining from the credential, . . . account information that identifies a financial account maintained by the customer at a financial institution and authorization information that allows debit access to the identified financial account” (emphasis added). Such a determination is not made from the “transaction ID” described in O’Leary. Instead, O’Leary teaches that the “transaction ID” be provided to the buyer and that the buyer include the transaction ID in the EFT credit message sent to the Internet

Merchant's VPL account (O'Leary, column 14, lines 61–63). The stated purpose of the “transaction ID” is to allow “the recipient of the credit . . . to match the received credit with a proposed purchase” (*id.*, column 14, lines 47–58). Rather than determine account information from the “transaction ID,” access to the buyer's account is instead made through the Payment Portal Processor (“PPP”) enhanced Wallet functionality, such as described at column 16, lines 18–35 of O'Leary.

Since O'Leary fails to disclose these limitations, independent Claim 1 is not anticipated by O'Leary. Further, while not directly relevant to an anticipation analysis, it is noted that O'Leary very clearly teaches away from using the “transaction ID” provided by the merchant to determine the customer's account information:

One of the features of the electronic credit pushes of the present invention is that the credit pushes can be made completely anonymously, with the recipient of the credit having no way to determine from where the credit originated.

(O'Leary, column 14, lines 53–57).

The structure taught by O'Leary of having the merchant supply a transaction ID that is included in the EFT credit message, but which otherwise relies on interactions between the buyer and the PPP enhanced Wallet, achieves this goal of anonymity. To allow the transaction ID to be used to determine account information for a financial account maintained by the customer would defeat this goal.

Independent Claim 14 is an apparatus claim that includes limitations similar to those of independent Claim 1 and is also believed to be patentable for the reasons set forth above.

2. Independent Claim 10

In explaining the rejection of independent Claim 10, the Office Action does not disagree with the general observation set forth in the previous Response that O’Leary and Chien fail to teach or suggest receipt by the payment network of “a first information packet” that comprises both “an electronic file having encrypted content” which, when decrypted, “identifies a financial account maintained by the customer,” and “transaction information.” Instead, the Office Action cites *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) for the proposition that “making integral what had been made previously [is] not patentable” (Office Action, page 3, lines 10–11). Applicants respectfully disagree that this is a holding of *Larson*.

The relevant portion of *Larson* was concerned with a claim limitation that recited “a brake drum integral with a said clamping means.” *Larson*, 340 F.2d at 968, 144 USPQ at 349. An argument had been proffered that because a brake disk was “rigidly secured” to a clamping means instead of being fabricated from a single piece, the claim limitation requiring that it be “integral” with the clamping means was not met. This is the argument that was rejected by the Board of Appeals of the Patent Office (“the Board”), with the CCPA affirming. The Board stated that “the term ‘integral’ is not limited to a fabrication of the parts from a single piece of metal, but is inclusive of other means for maintaining the parts fixed together as a single unit.” *Larson*, 340 F.2d at 968, 144 USPQ at 349. This was clearly a matter of construing the term “integral” in a particular context (“We are inclined to agree with the board’s construction of the term ‘integral’ as used in claim 12.” *Larson*, 340 F.2d at 968, 144 USPQ at 349). Construction of the term “integral” is irrelevant to independent Claim 10 since the word does not appear in the claim. Contrary to the assertion in the Office Action, there was no general holding in *Larson* that “making integral what had been made previously [is] not patentable.”

Since the cited art fails to disclose the claim limitation, independent Claim 10 is believed to be patentable.

3. Dependent Claims

The remaining claims depend from one of the independent claims discussed above, each of which is believed to be patentable over the cited art for the reasons set forth. Each of the dependent claims is additionally believed to be patentable by virtue of its dependence from a patentable independent claim.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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